

REMARKS

The Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

35 U.S.C. §103(a) Rejection – Richardson and Mital

The Examiner has rejected claims 32-49 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,028,764 issued to Richardson et al. (hereinafter referred to as "Richardson") in view of U.S. Patent No. 5,878,282 issued to Mital (hereinafter "Mital"). The Applicants respectfully submit that Richardson and Mital should not be combined because: (1) Richardson and Mital are from different fields or non-analogous arts; and (2) there is no suggestion or motivation to combine Richardson and Mital.

(1) Firstly, Richardson and Mital are from different fields or non-analogous arts. Richardson pertains to a portable computer, such as a laptop, with a separable display screen (see e.g., Title). The display screen detaches from the remainder of the computer (see e.g., Abstract). When the screen is detached communication may continue between the screen and the remainder of the computer using wireless communication (see e.g., Abstract). In contrast, Mital pertains to a portable information device having a form factor that is compatible with a 3.5" floppy or PCMCIA memory disk drive (see e.g., FIGS. 1, 2, and 4) that is generally used as a portable personal organizer (see e.g., column 1, line 21 and column 9, lines 43-65). The portable information device has a liquid crystal display (LCD) that is not separable or detachable. Furthermore, the computer and the portable information device do not communicate with one another wirelessly. The computer does not use the LCD of the portable information device to display

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information. In fact, when the portable information device is inserted into the floppy or PCMCIA slot, the LCD would be at least partially **concealed** (as shown in FIG. 1).

As discussed in the MPEP 2141.01(a), to rely on a reference under 35 U.S.C. 103, it must be analogous prior art. *"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned."* In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). The problem addressed in Mital would not logically have commended itself to an inventor's attention when he/she was considering the problem addressed in Richardson. Further an inventor could not possibly be aware of every teaching in every art. In re Wood, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979). For at least these reasons, Richardson and Mital are from non-analogous arts and should not be combined.

(2) Secondly, there is no suggestion or motivation to combine Richardson and Mital. To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). There is no such suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art.

The Examiner has repeatedly asserted that *"It would have been obvious to one of ordinary level of skill in the art to have modified Richardson with features of the*
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processor for use in a detachable display as taught by Mital because the subsystem can be operated independently by using own processor even detaching from the main computer". Applicants respectfully submit that this is insufficient.

There is no teaching or suggestion in the references themselves or in the knowledge generally available to one of ordinary level of skill in the art that the display screen should operate independently of the housing or that this would be desirable. Richardson makes it clear that the display screen does not operate independently as suggested by the Examiner, but rather wirelessly communicates with the processor of the housing. Therefore, the motivation proposed by the Examiner to make the display screen of Richardson "independent" of the processor of the housing goes against the explicit teachings of Richardson who discloses that they interact.

Furthermore, neither Richardson nor Mital discusses the desirability of allowing the display screen to operate independently. Mital discusses that the portable information device may be physically separated from the computer by great distances and then used as a personal organizer. In such cases, it may be desirable for the processing of the portable information device to be independent of the computer. However, neither reference discloses that a detachable display screen such as disclosed in Richardson may be used as a portable personal organizer, or that processing independence between the detachable display screen and the housing of the computer would otherwise be desirable. As was stated in *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984), "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

Accordingly, the portable information device discussed in Mital is not the same as the detachably connected display screen for the portable computer discussed in Richardson. Even though the portable information device discussed in Mital may have a

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CPU, there is absolutely no teaching or suggestion, either in the references themselves, or in the knowledge of one of ordinary level of skill in the art, to use the CPU discussed in Mital in the detachably connected display screen of Richardson.

It is not correct merely to focus on the differences between the prior art and the claimed invention, and then to state that the differences themselves are obvious. The claimed invention as a whole is to be considered. Further, it is impermissible to use the patent application as the basis for the obviousness rejection. As the Federal Circuit has stated, *"It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention"* (In re Fritch, 972, F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992) (quoting In re Fine, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

For one or more of the reasons mentioned above, the Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. Accordingly, claims 32-49 are believed to be allowable.

35 U.S.C. §103(a) Rejection – Richardson, Mital and Parrish

The Examiner has rejected claims 50-54 under 35 U.S.C. §103(a) as being unpatentable over Richardson in view of Mital and U.S. Patent No. 6,704,879 issued to Parrish (hereinafter referred to as "Parrish") The Applicants respectfully submit that the present claims are allowable over Richardson, Mital and Parrish.

Claim 50 pertains to a computing display subsystem comprising:
"a processor;
a display controller;

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*a storage device;
a communication adapter to communicate with a base station when the computing display subsystem is detached from the base station; and
a connector to allow the computing display subsystem to be connected and detached from the base station,
wherein the processor is operable to operate at a higher frequency power mode when the computing display subsystem is connected to the base station, and at a lower frequency power mode when the computing display subsystem is detached from the base station".*

Richardson, Mital and Parrish do not teach or suggest these limitations. In particular, Richardson and Mital do not teach or suggest a computing display subsystem comprising a processor. The discussion above is pertinent to this point. Parrish does not remedy what is missing from Richardson and Mital.

Furthermore, there is no teaching or suggestion in any of these references or in the knowledge generally available to one of ordinary level of skill in the art that a processor of a computing display subsystem be operable to operate at a higher frequency power mode and a lower frequency power mode. In Parrish the graphics adapter is not part of a computing display subsystem.

For at least one or more of these reasons, claim 50 and its dependent claims are believed to be allowable over Richardson, Mital and Parrish.

Conclusion

In view of the foregoing, it is believed that all claims now pending patentably define the subject invention over the prior art of record and are in condition for allowance. Applicants respectfully request that the rejections be withdrawn and the claims be allowed at the earliest possible date.

Request For Telephone Interview

The Examiner is invited to call Brent E. Vecchia at (303) 740-1980 if there remains any issue with allowance of the case.

Request For An Extension Of Time

The Applicants respectfully petition for an extension of time to respond to the outstanding Office Action pursuant to 37 C.F.R. § 1.136(a) should one be necessary. Please charge our Deposit Account No. 02-2666 to cover the necessary fee under 37 C.F.R. § 1.17 for such an extension.

Charge Our Deposit Account

Please charge any shortage to our Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Date: 7/5/06

Brent E. Vecchia

Brent E. Vecchia
Reg. No. 48,011

12400 Wilshire Boulevard
Seventh Floor
Los Angeles, California 90025-1030

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